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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,787	05/26/2000	Leslie Cheong	22698-702	9899

22852 7590 04/23/2003

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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/579,787

Applicant(s)

CHEONG ET AL.

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7, 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

The following example of the embedded hyperlink is provided.

p. 10 : amazon.com and barnesandnoble.com

applicant should review the specification (p. 36, 37, etc.) for additional hyperlinks present in the disclosure and delete as appropriate.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims. The specification, as originally filed does not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPO2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

3. Claims 1-14 and 28-56 (through respective parent claims) recite "selecting at least one credit account in the surrogate electronic system". However, on P 34 the specification recites " a surrogate system credit card is selected for purchase transaction 2306", which fails to recites a

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plurality of or multiple credit cards from which selection of the at least one credit account in the surrogate electronic system is made.

The specification also fails to recite proper basis for limitation "transferring funds equal to the amount due from at least one surrogate account to at least one credit account". On p. 34 the specification states "A surrogate system credit card is selected for the purchase transaction 2306. The amount due to complete the purchase transaction is determined by the surrogate system 2308. Funds are loaded from the user's account to the surrogate system credit card 2310." The specification is silent about transfer of funds equal to the amount due from at least one surrogate account to at least one credit account per claims 1, 28, 41 and 49.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-14 and 28-56 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 1-14 and 28-56 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 15-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 15 recites the limitation "the at least one client browser" in line 7 (p.72). There is insufficient antecedent basis for this limitation in the claim.

Dependent claims 16-27 inherit same weakness as parent claim 15.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 3, 5, 7, 15, 17, 20, 28, 30, 33, 41, 42, 44, 49, 50, and 52 are rejected under 35 U.S.C. 102(e) as being clearly by Boesch (US Pat. 6,295,522) (Boesch).

As per claims as aforementioned, Boesch discloses a method (and system) for surrogate control of electronic commerce transactions having method steps (or elements of a system) as per aforementioned claims. Please refer to Figure 3-6 and relevant description provided in the entire specification.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 4, 6, 12-14, 16, 18, 19, 25-27, 29, 31, 32, 38-40, 43, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boesch as applied to claim 1 (exemplary of claims 28, 41 and 49) and further in view of established business method practices.

Regarding claims 2, 16 and 29 Boesch fails to disclose fraud detection as claimed. However, official notice is taken that performing fraud detection (such as monitoring customer accounts for suspicious activities) for bank accounts and credit card accounts is old and well known. Furthermore, it is also old and well known that a varies of methodologies and techniques may be implemented to effectively detect frauds when monitoring electronic transactions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to performing fraud detection on the fund sources. Motivation is to prevent unauthorized and suspicious transaction whereby the account holder is protected against unauthorized fund withdrawal.

Regarding claims 4, 6, 12-14, 18, 19, 25-27, 31, 32, 38-40, 43, and 51, official notice is taken that selection of funding source for purchase accounts (example: electronic purse) are old and well known wherein a plurality of electronic accounts may be funded is old and well known.

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Similarly, limitations of claims 6 and 12-14 are old and well known and essential for record keeping, maintenance and balancing of accounts.

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement these features in order to facilitate customer shopping, selection of most desirable merchants and to maintain and reconcile account balances among various entities.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gephart US-PAT-NO: 6339766 teaches a Methods and systems for enabling an account holder to authorize the transfer of funds from an account using a limited-use account number. An account issuer establishes an account for the account holder and associates a regular account number and a limited-use account number with the account. The limited-use account number remains inactive until the account holder requests activation thereof. The regular account number is activated and is made available to the account holder for use in any desired number of transactions.

Biffar US-PAT-NO: 6205435 teaches a self-contained payment system uses circulating digital vouchers for the transfer of value. The system creates and transfers digital vouchers. A digital voucher has an identifying element and a dynamic log. The identifying element includes information such as the transferable value, a serial number and a digital signature.

Kenna et al. US-PAT-NO: 6108641 discloses a computer system for managing a plurality of accounts, each of the accounts being separated into a master account and at least one subaccount associated therewith, and at least one subaccount being a medical savings account (MSA). Each subaccount incorporates a subset of features available for the master account, the features corresponding to the specific needs dictated by the purpose of the subaccount.

Fleming US-PAT-NO: 5953710 teaches a Methods and credit or debit card systems are disclosed that allow the available credit to be determined by someone other than the card issuer and that allow a limit to be set on the number of expenditures that can be made. The methods and systems can be used to provide a mechanism for supervising credit or debit card usage. Methods and systems are disclosed which include a child's credit card account linked to a parent's credit or debit card account.

A system and method for allowing funds to be transferred instantly to

Jennings et al. US-PAT-NO: 5825003 discloses an account so that the funds are available to the beneficiary at the time they are sent, based on customer information which can be automatically accessed by the system, rather than needing to be manually entered.

Rossmann (EP 0 848 360 A1) discloses a system that handles electronic funds transfer transactions between a mobile telephone user and a trader by a mobile telephone billing system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. Draft faxes may be submitted directly to the examiner at (703) 746-5563.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.



Jagdish N. Patel

(Examiner, AU 3624)

4/18/03